

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Gerardo Orozco-Abundis

Confirmation No.: 1561

Application No.: 10/636,120

Examiner: Ghatt, Dave A.

Filing Date: August 7, 2003

Group Art Unit: 2854

Title: IMAGE CAPTURE DEVICE WITH A TELESCOPIC HINGE

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 14, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- | | |
|------------------|-----------|
| () one month | \$120.00 |
| () two months | \$450.00 |
| () three months | \$1020.00 |
| () four months | \$1590.00 |

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: May 3, 2005

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Respectfully submitted,

Gerardo Orozco-Abundis

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Gerardo Orozco-Abundis
Serial No.: 10/636,120
Filing Date: August 7, 2003
Group Art Unit: 2854
Examiner: Ghatt, Dave A.
Title: IMAGE CAPTURE DEVICE WITH A TELESCOPIC
HINGE

MAIL STOP: APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed February 1, 2005 finally rejecting Claims 1-18. Applicant filed a Notice of Appeal on March 14, 2005. Applicant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

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REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from the inventor recorded on December 23, 2003, in the Assignment Records of the United States Patent and Trademark Office at Reel 014827, Frame 0858.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-18 stand rejected pursuant to a Final Office Action mailed February 1, 2005. Claims 1-18 are presented for appeal.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF INVENTION

Independent Claim 1

Embodiments of the present invention as defined by independent Claim 1 are directed toward an image capture device (10) comprising a housing (12) and at least one telescopic hinge (40) operable to couple a lid (20) to the housing (12) (at least at page 2, paragraphs 0010 and 0011, page 3, paragraphs 0012-0014, figures 1 and 2).

Independent Claim 11

Embodiments of the present invention as defined by independent Claim 11 are directed toward an image capture device (10) comprising a lid (20), a housing (12) and at least two telescopic hinges (40) each having a plurality of extensible segments (42, 44, 46) where the at least two telescopic hinges (40) are pivotally coupling the lid (20) to the housing (12) (at least at page 2, paragraphs 0010 and 0011, page 3, paragraphs 0012-0014, page 4, paragraph 0017, figures 1 and 2).

GROUND OF REJECTIONS

1. Claims 1-6 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,812,285 issued to *Lin et al.* ("Lin").
2. Claims 1-9, 11 and 13-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,150,896 issued to *Wakeman* ("Wakeman").
3. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wakeman* in view of U.S. Patent No. 3,832,937 issued to *Moore et al.* ("Moore").
4. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wakeman* in view of U.S. Patent No. 6,607,157 issued to *Duescher* ("Duescher").

ARGUMENT

A. Standard

35 U.S.C. § 102

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument

1. Claims 1-10

Claims 1-6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Lin*. Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Wakeman*. In addition, claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wakeman* in view of *Moore*. Of these claims, Claim 1 is independent. Applicant respectfully submits that independent Claim 1 is patentable over both *Lin* and *Wakeman*, and thus remaining claims 2-10, which depend from independent Claim 1 are also patentable.

Lin Reference

In the Final Office Action the Examiner states that “*Lin* teaches hinge element 4 that slides inward or outward in an overlapping manner with the member generally shown at 6, as the cylindrical sections of a small hand telescope do. This is all that is required to meet this particular claim limitation.” (Final Office Action, page 2). Applicant respectfully disagrees.

Lin appears to disclose a cover 1 of a scanning device having support arm 4 with a horizontal axial body 5 connected therewith such that the axial body 5 is positioned within a recess 6 formed in a main body 2 of the scanner device (*Lin*, column 2, lines 20-31, figures 3, 4a, 4b and 5). *Lin* also appears to disclose that the main body recess 6 of *Lin* is formed to enable the support arm 4 to move upward and downward therein, thereby resulting in variable positioning of the cover of *Lin* relative to the main body of the scanner device of *Lin* (*Lin*, column 2, lines 35-44, figure 5).

Independent Claim 1 recites “a housing” and “at least one telescopic hinge operable to couple a lid to said housing.” At least because Applicant’s Claim 1

separately recites a “telescopic hinge” and a “housing,” the support arm 4/axial body 5 of *Lin* referred to by the Examiner must be construed in the *Lin* reference separate from the main body of the scanner device of *Lin*. In contrast, the Examiner appears to consider a portion of the main body of the scanner device of *Lin* to be both the “housing” and the “telescopic hinge” recited by independent Claim 1, which is improper. Thus, the support arm 4 of *Lin*, which couples the cover of *Lin* to the main body of the scanner device of *Lin*, is not, by itself, “a telescopic hinge” as recited by independent Claim 1. The support arm 4 of *Lin* appears to be formed as a single, rigid body that is not “telescopic” nor does it appear to be capable of providing any telescoping function. Thus, Applicant respectfully submits that *Lin* does not disclose or even suggest “at least one telescopic hinge” coupling a lid to a housing as recited by independent Claim 1. Therefore, for at least this reason, Applicant submits that *Lin* does not anticipate independent Claim 1.

Wakeman Reference

In the Final Office action, the Examiner states the following:

[W]ith respect to the requirement for a telescopic hinge Wakeman teaches a cylindrical hinge element 31 that slides inward or outward in an overlapping manner with the second cylindrical member . . . as the cylindrical sections of a small hand telescope do. This is all that is required to meet this particular claim limitation.

(Final Office Action, page 3). Applicant respectfully disagrees.

Wakeman appears to disclose a support arm 30 for coupling a cover 27 to a copier housing 21 (*Wakeman*, column 3, lines 45-51, figures 5 and 6). *Wakeman* also appears to disclose that the support arm 30 of *Wakeman* includes a positioning rod 31 that is slidably inserted into a housing hole 32 formed in the copier housing 21 to enable variable positioning of the cover relative to the copier housing of *Wakeman* (*Wakeman*, column 3, lines 52-5-, figures 5 and 6).

As discussed above, independent Claim 1 recites “a housing” and “at least one telescopic hinge operable to couple a lid to said housing.” At least because

Applicant's Claim 1 separately recites a "telescopic hinge" and a "housing," the support arm 30 of *Wakeman* must be construed in the *Wakeman* reference separate from the copier housing of *Wakeman*. In contrast, the Examiner appears to consider a portion of the copier housing 21 of *Wakeman* to be both the "housing" and the "telescopic hinge" recited by independent Claim 1, which is improper. Thus, the support arm 30 of *Wakeman*, which couples the cover of *Wakeman* to the copier housing of *Wakeman* is not, by itself, "a telescopic hinge" as recited by independent Claim 1. The support arm 30 of *Wakeman* appears to be formed as a single, rigid body that is not "telescopic" nor does it appear to be capable of providing any telescoping function. Thus, Applicant respectfully submits that *Wakeman* does not disclose or even suggest "at least one telescopic hinge" coupling a lid to a housing as recited by independent Claim 1. Therefore, for at least this reason, Applicant submits that *Wakeman* does not anticipate independent Claim 1.

Accordingly, Applicant respectfully submits that independent Claim 1 is patentable over the cited and applied references. Further, Claims 2-10, which depend from independent Claim 1, are also patentable at least because they incorporate the limitations of independent Claim 1 and also add additional elements that further distinguish *Lin* and/or *Wakeman*. Further, *Moore* does not remedy the deficiencies of either *Lin* or *Wakeman*. Therefore, Applicant respectfully submits that the rejection of Claims 1-10 was improper and that Claims 1-10 are in condition for allowance.

2. Claims 11-18

Applicant respectfully submits that Claims 11-18 are separately patentable relative to claims 1-10. Claims 11 and 13-18 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Wakeman*. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wakeman* in view of *Duescher*. Of these claims, Claim 11 is independent. Applicant respectfully submits that independent Claim 11 is patentable over *Wakeman*, and thus remaining Claims 12-18, which depend from independent Claim 11, are also patentable.

With respect to independent Claim 11, the Examiner states that "*Wakeman* shows two telescopic hinges, each having a plurality of segments" (Final Office

Action, page 5). Applicant respectfully disagrees.

Independent claim 11 recites “a lid,” “a housing” and “at least two telescopic hinges, each having a plurality of extensible segments . . . pivotally coupling said lid to said housing.” As discussed above, at least because Applicant’s Claim 11 separately recites “at least two telescopic hinges” and “a housing,” the support arm 30 of *Wakeman* must be construed in the *Wakeman* reference separate from the copier housing of *Wakeman*. In contrast, the Examiner appears to consider a portion of the copier housing 21 of *Wakeman* to be both the “housing” and the “telescopic hinges” recited by independent Claim 11, which is improper. Thus, the support arm 30 of *Wakeman*, which couples the cover of *Wakeman* to the copier housing of *Wakeman* is not, by itself, a “telescopic hinge” as recited by independent Claim 11. The support arm 30 of *Wakeman* appears to be formed as a single, rigid body that is not “telescopic” nor does it appear to be capable of providing any telescoping function. Nor does the support arm 30 of *Wakeman* include “a plurality of extensible segments” as recited by independent Claim 11. Thus, Applicant respectfully submits that *Wakeman* does not disclose or even suggest “at least two telescopic hinges” coupling a lid to a housing as recited by independent Claim 11. Therefore, for at least this reason, Applicant submits that *Wakeman* does not anticipate independent Claim 11.

Claims 13-18 which depend from independent Claim 11 are also not anticipated by *Wakeman* at least because they incorporate the limitations of Claim 11 and also add additional elements that further distinguish *Wakeman*. Further, Claim 12 depends from independent Claim 11. Accordingly, at least because Claim 11 is in condition for allowance, Claim 12 is also in condition for allowance. Moreover, *Duescher* does not remedy any of the deficiencies of *Wakeman*. Therefore, Applicant respectfully submits that the rejection of Claims 11-18 was improper and that Claims 11-18 are in condition for allowance.

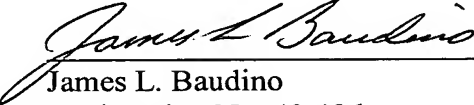
CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

Date: May 3, 2005


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APPENDIX A

1. An image capture device, comprising:
a housing; and
at least one telescopic hinge operable to couple a lid to said housing.
2. The image capture device of claim 1, wherein said at least one telescopic hinge releasably couples said lid to said housing.
3. The image capture device of claim 1, further comprising at least one slot in said housing, said at least one slot operable to engage with at least a portion of said at least one telescopic hinge to prevent inadvertent decoupling of said at least one telescopic hinge from said housing.
4. The image capture device of claim 1, wherein said housing comprises at least one recess corresponding to said at least one telescopic hinge.
5. The image capture device of claim 1, wherein said housing comprises at least one recess, each of said at least one telescopic hinge being inserted into a corresponding one of said at least one recess to couple said lid with said housing.
6. The image capture device of claim 1, wherein said at least one telescopic hinge comprises a plurality of segments.
7. The image capture device of claim 1, wherein said at least one telescopic hinge comprises at least one segment slidably engaged with at least another segment.
8. The image capture device of claim 1, wherein at least one segment of said at least one telescopic hinge is adapted to be disposed in a recess of said housing.
9. The image capture device of claim 8, wherein at least another segment of said at least one telescopic hinge is slidably engaged with said at least one segment.

10. The image capture device of claim 9, wherein a third segment of said at least one telescopic hinge is slidably engaged with said at least another segment.

11. An image capture device, comprising:
a lid;
a housing; and
at least two telescopic hinges, each having a plurality of extensible segments, said at least two telescopic hinges pivotally coupling said lid to said housing.

12. The image capture device of claim 11, wherein a first segment of said plurality of segments comprises a latching member operable to engage with a slot in said housing.

13. The image capture device of claim 11, wherein a first segment of said plurality of segments comprises a ledge near an end of said first segment.

14. The image capture device of claim 13, wherein said ledge surrounds an opening at said end.

15. The image capture device of claim 13, wherein a second segment of said plurality of segments comprises a latching member operable to engage with said ledge.

16. The image capture device of claim 15, wherein said latching member surrounds an end of said second segment.

17. The image capture device of claim 11, wherein said at least two telescopic hinges releasably couple said lid to said housing.

18. The image capture device of claim 11, wherein a segment of said plurality of segments comprises a channel operable to accept a pin to pivotally couple said lid to said hinge.